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EXAMINER

VIGUSHIN, JOHN B

ART UNIT

PAPER NUMBER

2827

DATE MAILED: 01/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,322

Applicant(s)

DETCHEVERRY ET AL.

Examiner

John B. Vigushin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 10 is/are rejected.
- 7) ☒ Claim(s) 2 and 5-9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 8-10 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, Claims 8-10 have not been further treated on the merits.

2. Claims 2-3 and 5-7 are objected to because of the following informalities:

- a) In Claim 2, line 5: "electrode" should be changed to --electrodes--.
- b) Claim 3 depends from Claim 2 and therefore inherits the defect of the claim.
- c) In Claim 5, the language of the claim is somewhat confusing due to the

punctuation and some wording. The following version of Claim 5, recommended by the Examiner, would better set forth the contemplated invention:

A transponder as claimed in claim 1 or 2, characterized in that the integrated circuit comprises a second electrode; a stack consisting of a semiconductor layer, a third layer of dielectric material, and a third patterned electrically conductive layer that comprises the second electrode of the integrated circuit is present on the second patterned layer; and a fourth layer of dielectric material is present on said stack.

d) In Claim 6, the reference numerals (5, 105) are attributed to the semiconductor layer, while in Claim 5, the numerals (5, 105) are attributed to the dielectric layer and (6, 106) are attributed to said semiconducting layer. Since the reference numerals have no effect on the scope of the claims (see MPEP § 608.01(m)), the Examiner recommends removing all the reference numerals in Claims 1-10 in order

to avoid this and any other such reference numeral inconsistencies that may still be present in Claims 1-10 as originally filed.

- e) Claim 7 depends from Claim 5 and therefore inherits the defects of the claim.
- f) In Claim 9, line 4: "surface" should be changed to --surfaces--.
- g) In Claim 9, line 4: "one another" should be changed to --each other--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim recites that "the first and the third capacitor electrode *at the same time form the antenna*" (italic emphasis added by the Examiner). Does the Applicant contemplate that the electrodes are also part of the antenna structure, or, does the Applicant contemplate that the capacitor electrodes are formed (in a manufacturing process) at the same time as the antenna?

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Bickley et al. (US 5,430,441).

Regarding Claim 1, Bickley et al. discloses, in Fig. 5: a transponder (the multilayer circuit of transponding tag 14) provided with an integrated circuit 34 (on IC chip 66; col.6: 25-32), an antenna 22 (col.4: 64-66), a first capacitor 44 (col.5: 5-7 and 27-30) provided with a dielectric 58 and a first and second electrode (top and bottom surfaces of dielectric 58); transponder 14 comprises a stack of layers, i.e.: a first dielectric layer 54; a first patterned electrically conductive layer (on surface 26 of first dielectric 54) of which the antenna 22 forms a part; a second dielectric layer 58; a second patterned electrically conductive layer (on surface 60 of dielectric layer 58); the second patterned conductive layer comprises a first electrode 68 of the integrated circuit 34 (col.6: 25-29) and the second capacitor electrode (i.e., the upper electrode) of capacitor 44.

Regarding Claim 4, Bickley et al. further discloses, in Figs. 3 and 5, that the first patterned layer (comprising the conductive foils of antenna 22) occupies a larger surface area (Fig. 3 and col.5: 14-17) than does the second patterned layer (comprising conductive foil traces 68, the upper electrode of capacitor 44 and inductor coil 46).

Regarding Claim 10 (as it depends from Claims 1 or 4), Bickley et al. discloses, in Fig. 5: an appliance (a transponding tag 14) with a transponder (the multilayer circuit of transponding tag 14 as claimed in Claims 1 or 4) which comprises an integrated

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circuit 34 (on IC chip 66; col.6: 25-32), an antenna 22 (col.4: 64-66), and a first capacitor 44 (col.5: 27-30).

Allowable Subject Matter

7. Claims 2, 5-7 and 9 would be allowable if rewritten to overcome the objections set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

8. Claim 3 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter:

Regarding Claims 2-3, patentability resides in that *the first patterned layer comprises the first and a third capacitor electrode, the second patterned layer comprises a fourth capacitor electrode and the third and fourth capacitor electrodes form a second capacitor in conjunction with the second layer of dielectric material*, in combination with the other limitations of the broadest claim, Claim 2.

Regarding Claims 5-7, patentability resides in that *the stack consisting of a semiconductor layer, a third layer of dielectric material, and a third patterned electrically conductive layer that comprises the second electrode of the integrated circuit is present on the second patterned layer*, in combination with the other limitations of the broadest claim, Claim 5.

Regarding Claim 9 (as it depends from Claim 4), patentability resides in that *the first and the second contact surfaces are in contact with each other*, in combination with the other limitations of the claim.

10. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Regarding Claim to Priority Under 35 USC § 119(a)-(d)

11. The following foreign priority document has NOT been received in the instant Application file: **Application No. 00200471.1** (*filing date: 14 February 2000*).

Concerning Information Disclosure Statement (IDS)

12. The Search Report submitted with the IDS of July 05, 2001 (Paper No. 4) has been considered by the Examiner.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Morizumi et al. (US 6,459,588 B1) discloses a transponder comprising a capacitor with upper and lower electrodes 47c and 47a, respectively, and dielectric layer 47b, and antenna 43 on the same layer as lower capacitor electrode 47a (Fig. 8f).

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Vigushin whose telephone number is 703-308-1205. The examiner can normally be reached on 8:30AM-5:00PM Mo-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Talbott can be reached on 703-305-9883. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7382 for regular communications and 703-308-7382 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



John B. Vigushin
Examiner
Art Unit 2827

jbv
January 13, 2003